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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,716	07/18/2000	Kyoji Saito	P19789	9554

7055 7590 11/17/2003

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EXAMINER

PHAN, TAM T

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 11/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/618,716

Applicant(s)

SAITO, KYOJI

Examiner

Tam (Jenny) Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☒ Claim(s) 1 and 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,4,7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-d, which papers have been placed of record in the file.
2. The effective filing date for the subject matter defined in the pending claims in this application is 11/11/1999.

Information Disclosure Statement

3. Initialed and dated copies of Applicant's IDS form 1449, Paper No. 3, 4, 7, are attached to the instant Office action.

Specification

4. The disclosure is objected to because of the following informalities: page 13 lines 25-26, "Contents-Type multipart/mixed" should read "Contents-Type: multipart/mixed".
5. Appropriate correction is required.

Claim Objections

6. Claims 1 and 4 are objected to because of the following informalities: Page 31 lines 7, page 32 lines 2, "printer pints" should read "printer prints". Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claims 8-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 8 recites the limitation "the according to claim 7". Such sentences are causing difficulty for the examiner to interpret the claimed invention.

10. Claim 9 recites the limitation "The apparatus" in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim.

11. Claim 10 recites the limitation "An image receiving apparatus comprising: receiving E-mail data via a network; converting the received E-mail data to image data..." in lines 1-3 of the claim. It is unclear how an apparatus could comprise the steps of receiving and converting. A method not an apparatus should comprise these steps.

12. Claims 11-12 contained similar sentence structures as in claim 10 and therefore are rejected using the same rationale.

13. For examination purposes, claims 8-12 will be treated as followed:

8. The method according to claim 7, further comprising abstracting specific information containing image data from the E-mail data if the E-mail data is error mail, wherein the specific information is converted to image data, and the image data is printed.

9. The method according to claim 7, further comprising editing the image data, wherein if the Email data is error mail, the image data is edited to be contained in one page, and the edited image data is printed.

10. An image receiving method comprising: receiving E-mail data via a computer network; converting the received E-mail data to image data; printing the image data; and identifying whether or not the E-mail data is error mail, wherein whether the E-mail data is a multipart structure or a single-part structure is determined, if the E-mail data is the multipart structure, an original message part to which an original message is appended is searched and whether or not an image data fixed code is included in the top of an image part of the original message

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part is checked, and if the E-mail data is the single-part structure, the E-mail data is scanned to search the image data fixed code.

11. The method according to claim 10, further comprising abstracting specific information containing image data from the E-mail data if the E-mail data is error mail, wherein the specific information is converted to image data, and the image data is printed.

12. The method according to claim 10, further comprising editing the image data, wherein if the E-mail data is error mail, the image data is edited to be contained in one page, and the edited image data is printed.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al. (U.S. Patent Number 6,618,749), hereinafter referred to as Saito and further in view of Tomohiro et al. (Publication Number 10308766), hereinafter referred to as Tomohiro.

16. Regarding claim 1, Saito disclosed an image receiving apparatus comprising: a receiver, the receiver receives E-mail data via a computer network (Figure 1, column 3 lines 37-40, column 9 lines 36-37, column 10 lines 3-4); a converter, the converter converts the E-mail data received by the receiver to image data (column 3 lines 43-47, column 4 lines 36-42, column 10 lines 16-17); a printer, the printer prints the image data (column 4 lines 23-26, column 9 lines 38-41, column 10 lines 5-8); and an identifier, the identifier identifies whether or not the E-mail data is error mail (column 4 lines 23-26, column 9 lines 38-41, column 10 lines 5-8)

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17. Saito did not specifically disclose an identifier wherein the identifier identifies the error mailer based on whether or not received mail data includes a character string that a sender of error mail may describe in a sender field of the E-mail data. However, in an analogous art, Tomohiro disclosed an error mail that includes a character string from a sender of the error mail (Figures 10-11 and 18). In addition, Saito disclosed in his invention that the entire transmit data is stored in transmit data storage to identify error mail (column 8 lines 61-62). It is possible to extract part of the transmit data and use it as information to identify receive mail where information includes the information contained in the header (column 8 lines 61-67).

18. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the identifier of Saito's apparatus wherein the identifier identifies the error mailer based on whether or not received mail data includes a character string that a sender of error mail may describe in a sender field of the E-mail data in order to save storage space because the entire transmit data did not have to be stored in the transmit data storage to identify error mail (Saito, column 8 lines 61-62).

19. Regarding claim 2, Saito disclosed an apparatus further comprising an abstracter the abstracter abstracts specific information containing image data from the E-mail data if the E-mail data is error mail (column 5 lines 30-39, column 9 lines 42-47, column 10 lines 9-14), wherein the converter converts the specific information to image data (column 10 lines 16-17), and the printer prints the image data (column 10 lines 22-27).

20. Regarding claim 3, Saito disclosed an apparatus further comprising an editor, the editor edits the image data, wherein if the E-mail data is error mail, the image data is

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edited and the edited image data is printed (column 9 lines 48-59, column 10 lines 18-28).

21. Regarding claim 4, Saito disclosed an image receiving apparatus comprising: a receiver, the receiver receives E-mail data via a computer network (Figure 1, column 3 lines 37-40, column 9 lines 36-37, column 10 lines 3-4); a converter, the converter converts the E-mail data received by the receiver to image data (column 3 lines 43-47, column 4 lines 36-42, column 10 lines 16-17); a printer, the printer prints the image data (column 4 lines 23-26, column 9 lines 38-41, column 10 lines 5-8); and an identifier, the identifier identifies whether or not the E-mail data is error mail (column 4 lines 23-26, column 9 lines 38-41, column 10 lines 5-8), and the identifier scans the E-mail data to search the image data fixed code (column 7 lines 47-50). Tomohiro disclosed a multipart error mail displaying "Content-Type: multipart/mixed" header field (Figures 10 and 11) and a single-part structure error mail displaying "Content-Type: text" (Figure 11). Saito disclosed that it is possible to extract part of the transmit data and use its header information to identify error mail (column 8 lines 61-67) to allow the identifier to scan the E-mail data to search the image data fixed code (column 7 lines 47-50).

22. Regarding claim 5, Saito disclosed an apparatus further comprising an abstracter, the abstracter abstracts specific information containing image data from the E-mail data if the E-mail data is error mail (column 5 lines 30-39, column 9 lines 42-47, column 10 lines 9-14), wherein the converter converts the specific information to image data (column 10 lines 16-17), and the printer prints the image data (column 10 lines 22-27).

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23. Regarding claim 6, Saito disclosed further comprising an editor, the editor edits the image data, wherein if the E-mail data is error mail, the image data is edited and the edited image data is printed (column 9 lines 48-59, column 10 lines 18-28).

24. Regarding claims 7-9, the method corresponds directly to the apparatus of claims 1-3, and thus these claims are rejected using the same rationale.

25. Regarding claims 10-12, the method corresponds directly to the apparatus of claims 4-6, and thus these claims are rejected using the same rationale.

26. Since all the limitations of the claimed invention were disclosed by the combination of Saito and what would have been obvious to one of ordinary skill in the art at the time of the invention was made, claims 1-12 are rejected.

27. Claims 1 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al. (U.S. Patent Number 6,618,749), hereinafter referred to as Saito and further in view of what would have been obvious to one of ordinary skill in the art at the time of the invention was made.

28. Regarding claim 1, Saito disclosed an image receiving apparatus comprising: a receiver, the receiver receives E-mail data via a computer network (Figure 1, column 3 lines 37-40, column 9 lines 36-37, column 10 lines 3-4); a converter, the converter converts the E-mail data received by the receiver to image data (column 3 lines 43-47, column 4 lines 36-42, column 10 lines 16-17); a printer, the printer prints the image data (column 4 lines 23-26, column 9 lines 38-41, column 10 lines 5-8); and an identifier, the

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identifier identifies whether or not the E-mail data is error mail (column 4 lines 23-26, column 9 lines 38-41, column 10 lines 5-8)

29. Saito did not specifically disclose an identifier wherein the identifier identifies the error mailer based on whether or not received mail data includes a character string that a sender of error mail may describe in a sender field of the E-mail data. However, it was well known in the art that origin of transmission field of the error mail contains specific character string (MAILER-DAEMON, etc.) given by a mail server. In addition, Saito disclosed in his invention that the entire transmit data is stored in transmit data storage to identify error mail (column 8 lines 61-62). It is possible to extract part of the transmit data and use it as information to identify receive mail where information includes the information contained in the header (column 8 lines 61-67).

30. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the identifier of Saito's apparatus wherein the identifier identifies the error mailer based on whether or not received mail data includes a character string that a sender of error mail may describe in a sender field of the E-mail data in order to save storage space because the entire transmit data did not have to be stored in the transmit data storage to identify error mail (Saito, column 8 lines 61-62).

31. Regarding claim 7, the method corresponds directly to the apparatus of claims 1, and thus is rejected using the same rationale.

32. Since all the limitations of the claimed invention were disclosed by the combination of Saito and what would have been obvious to one of ordinary skill in the art at the time of the invention was made, claims 1 and 7 are rejected.

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33. Claims 4-6 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al. (U.S. Patent Number 6,618,749), hereinafter referred to as Saito '749 and further in view of Saito et al. (EP 0923226), hereinafter referred to as Saito '226.

34. Regarding claim 4, Saito '749 disclosed an image receiving apparatus comprising: a receiver, the receiver receives E-mail data via a computer network (Figure 1, column 3 lines 37-40, column 9 lines 36-37, column 10 lines 3-4); a converter, the converter converts the E-mail data received by the receiver to image data (column 3 lines 43-47, column 4 lines 36-42, column 10 lines 16-17); a printer, the printer prints the image data (column 4 lines 23-26, column 9 lines 38-41, column 10 lines 5-8); and an identifier, the identifier identifies whether or not the E-mail data is error mail (column 4 lines 23-26, column 9 lines 38-41, column 10 lines 5-8), and the identifier scans the E-mail data to search the image data fixed code (column 7 lines 47-50).

35. Saito '749 did not specifically disclose an identifier wherein the identifier determines whether the E-mail data is a multipart structure or a single-part structure, if the E-mail data is the multipart structure, the identifier searches an original message part to which an original message is appended and checks whether or not an image data fixed code is included in the top of an image part of the original message part and if the E-mail data is the single-part structure, the identifier scans the E-mail data to search the image data fixed code.

36. However, in an analogous art, Saito '226 disclosed a multipart error mail displaying "Content-Type: multipart/mixed" header field (Figure 5) and because Saito '749 disclosed that it is possible to extract part of the transmit data and use its header

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information to identify error mail (column 8 lines 61-67), it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the apparatus of Saito '749 with the teachings of Saito '226 to include identify the single-part or multipart structure mail in order to save storage space since the entire transmit data did not have to be stored in the transmit data storage to identify error mail (Saito '749, column 8 lines 61-62).

37. Regarding claim 5, Saito '749 disclosed an apparatus further comprising an abstracter, the abstracter abstracts specific information containing image data from the E-mail data if the E-mail data is error mail (column 5 lines 30-39, column 9 lines 42-47, column 10 lines 9-14), wherein the converter converts the specific information to image data (column 10 lines 16-17), and the printer prints the image data (column 10 lines 22-27).

38. Regarding claim 6, Saito '749 disclosed further comprising an editor, the editor edits the image data, wherein if the E-mail data is error mail, the image data is edited and the edited image data is printed (column 9 lines 48-59, column 10 lines 18-28).

39. Regarding claims 10-12, the method corresponds directly to the apparatus of claims 4-6, and thus these claims are rejected using the same rationale.

40. Since all the limitations of the claimed invention were disclosed by the combination of Saito and what would have been obvious to one of ordinary skill in the art at the time of the invention was made, claims 4-6 and 10-12 are rejected.

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Conclusion

41. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to the enclosed PTO-892 for details.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam (Jenny) Phan whose telephone number is (703) 305-4665. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Powell can be reached on 703-305-9703. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Marc Thompson
Primary Examiner
Art Unit 2142
703-308-6750

tp
October 21, 2003

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PRIMARY EXAMINER